

### **REMARKS**

An Office Action has been issued in the subject application in which:

- 1) claims 1, 4, 5, 9, 16, 19, and 20 were rejected under 35 U.S.C. § 102; and
- 2) claim 1, 4, 5, 16, and 19 were rejected under 35 U.S.C. § 103.

Summarizing the Amendment, claims 1 and 16 have been amended to more distinctly claim and particularly point out the subject matter which Applicant regards as the invention. Claims 1, 4, 5, 9, 16, 19, and 20 remain in the application.

Each of the rejections is traversed hereunder in the order presented in the Office Action. Reconsideration of the subject application as amended is respectfully requested.

### **REJECTIONS UNDER 35 U.S.C. § 102**

Claims 1, 4, 5, 9, 16, 19, and 20 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,321,513 to Meixner. Applicant traverses these rejections.

#### **Requirements for Anticipation**

The Federal Circuit stated in *W.L. Gore & Associates v. Garlock, Inc.* [721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)] that an anticipation rejection under 35 U.S.C. § 102 “requires the disclosure of a single prior art reference of each element of the claim under consideration.” It is not enough, however, that the prior art reference disclose all the claimed elements in isolation. Rather, as stated by the Federal Circuit, “[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim” [*Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984)]. Likewise, the Court of Customs and Patent Appeals (CCPA) stated in *In re Wilder* [429 F.2d 447, 166 USPQ 545, 548 (C.C.P.A. 1976)]:

Simply stated, a prior publication or patent description will be considered as anticipatory when its disclosure is at once specific and enabling with regard to the particular subject matter at issue. In effect, a prima facie case is made out whenever a reference is shown to contain a disclosure which is specific as to every critical element of the appealed claims.

In other words, a prima facie case of anticipation is established when the Patent Office provides:

- a) a single reference
- b) that teaches or enables
- c) each of the claimed elements (arranged as in the claim)

- d) expressly or inherently
- e) as interpreted by one of ordinary skill in the art.

If any one of these elements is not present, the prima facie case of anticipation is not established. In the instant case, it is respectfully submitted that the Meixner patent fails to meet these requirements.

#### The Cited Reference

U.S. Patent No. 6,321,513 to Meixner discloses a method in which a packaging material can be used which compresses a product during or after a packaging procedure or exerts a uniform multi-side or all-side pressure on a packaged commodity. Meixner states that the method is advantageous in the packaging of diapers, hygiene paper, sanitary pads or the like. Meixner also states that the volume of diapers can be compressed by up to half in accordance with his method. (See column 4, lines 23-31.)

As discussed below, the Meixner patent fails to teach or suggest packaging a single absorbent article to yield an individually packaged single absorbent article that is highly compact and portable.

#### The Present Invention

The invention as set forth in claim 1 recites a highly compact and portable absorbent article that includes:

- a single absorbent article that is compressible and reconfigurable... ; and
- a packaging for retaining said single absorbent article in said compressed condition

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- said absorbent article occupying a volume of space that is reduced by at least about 30% when said absorbent article is reconfigured from [a] normal condition to [a] compressed condition; and
- said packaging for retaining said single absorbent article when said article is in said compressed condition, thereby yielding an individually packaged compact and portable absorbent article.

The invention as set forth in independent claim 16 recites a method for packaging an absorbent article to yield an individually packaged single absorbent article that is compact and portable.

The method includes:

- providing an absorbent article ... ;
- reconfiguring the absorbent article such that the volume of space is reduced by at least 30%;

retaining the absorbent article when reconfigured within [a] packaging, thereby yielding an individually packaged compact and portable absorbent article.

### Discussion

The Meixner patent fails to teach or suggest packaging a single compressed absorbent article within a single packaging to yield an individually packaged absorbent article. Rather, Meixner claims that his method may be used to package diapers. This is a conventional packaging system that is used to package a plurality of diapers into plastic packaging that is then either sold within the packaging or repackaged into cardboard packaging.

Accordingly, the Meixner system fails to teach or suggest a single absorbent article that is compressed and then packaged while compressed to yield an individually packaged absorbent article as recited in claim 1, or a method of packaging a single absorbent article as recited in claim 16.

It is respectfully submitted that the Meixner patent fails to teach or suggest the absorbent article of claim 1 and the method of claim 16, and, therefore, that claims 1 and 16 are patentable. In addition, claims 2, 4, and 9 depend from claim 1, and claims 19 and 20 depend from claim 16. Each of these dependent claims recites additional features of the invention. For reasons analogous to those presented in relation to claims 1 and 16, it is respectfully submitted the Meixner patent also fails to teach or suggest the absorbent article of claims 4, 5, and 9, and the methods of claims 19 and 20, and, therefore, that claims 4, 5, 9, 19, and 20 are patentable.

### REJECTIONS UNDER 35 U.S.C. § 103

Claims 1, 4, 5, 16, and 19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,936,460 to Meyer in view of U.S. Patent No. 4,110,276 to DesMarais. Applicant traverses these rejections.

#### Requirements for Obviousness

The Federal Circuit stated in *In re Oeticker* [977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992)], “[i]f examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent.” The CCPA interpreted prima facie obviousness in *In re Lintner* [458 F.2d 1013, 173 USPQ 560, 562 (C.C.P.A. 1972)] as follows:

In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination or other modification.

In *In re Rinehart* [531 F.2d 1048, 189 USPQ 143 147 (C.C.P.A. 1976)], the CCPA added that the prima facie case requires that the teachings of the reference “appear to have suggested the *claimed subject matter*.” In view of these decisions, a prima facie case of obviousness is established when the Patent Office provides:

- a) one or more references
- b) that were available to the inventor and
- c) that teach
- d) a suggestion to combine or modify the references,
- e) the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

If any one of these elements is not present, the prima facie case of obviousness is not established. In the instant case, it is respectfully submitted that the Meyer and DesMarais patents, either alone or in combination, fail to meet these requirements.

### **The Cited References**

#### U.S. Patent No. 5,462,166 to Meyer

U.S. Patent No. 5,462,166 to Meyer discloses a shelf or counter display 10 for display of a soft toy 12 and for holding a plurality of individual packages 14 each containing a soft toy 12 in the compressed state. The toy 12 is constituted by a compressible filler or stuffing and a flexible outer skin on which characterizing visual features such as eyes and a nose are printed. The packages 14 each have a transparent, gas impervious front sheet 15a and a gas impervious rear sheet 15b which are sealed together throughout a continuous area surrounding a soft toy 12 located between the front and rear sheets. The toy 12 in each package is compressed from front to back to twenty percent or less of its unstressed thickness and a vacuum is drawn between the front and rear sheets thereby to hold the toy in the compressed state. (See column 2, lines 22–37, and FIGS. 1–3 and 5.)

The display 10 may be seen to comprise a pair of trays 16 and 17 located in side-by-side relationship and an upstanding rear wall 20 which extends above the tops of the packages 14 to provide a space for containing descriptive printed matter. The tray 16 has a bottom 21 and upstanding forward wall 22 and a pair of triangular side walls 24 and 25 which extend a short distance forwardly of the front wall 22 and terminate at the front edge of the bottom panel 21. The tray 17 includes a front wall 28 and a pair of side walls 30. The wall 28 is located farther forward than is the wall 22 to provide a section in which one of the toys 12 may be placed in its uncompressed unpackaged state. (See column 2, lines 38–50, and FIGS. 1 and 6.)

U.S. Patent No. 4,110,276 to DesMarais

U.S. Patent No. 4,110,276 to DesMarais discloses a resilient polyester foam material for use in products such as catamenial tampons. (See the abstract.)

**Discussion**

Independent claims 1 and 16 are discussed above. The Meyer and DesMarais patents fail to teach or suggest reconfiguring an absorbent article as recited in claims 1 and 16 to yield an individually packaged absorbent article. Rather, Meyer teaches compressing a stuffed toy. The DesMarais patent discloses polyester foam material. Accordingly, it is respectfully submitted that the Meyer and DesMarais patents are so unrelated that one skilled in the art would not be motivated to combine the teachings of the two. Indeed, stuffed toys (Meyers) and polyester foam material for catamenial tampons (DesMarais) are absolutely incongruent and incompatible art fields.

Accordingly, it is respectfully submitted that the invention as recited in claims 1 and 16 would not be obvious to one skilled in the art from the combination of the teachings of the Meyer and DesMarais patents.

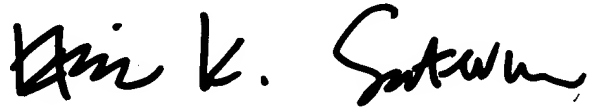
In addition, claims 4, 5, and 9 depend from claim 1, and claims 19 and 20 depend from claim 16. For reasons analogous to those presented in relation to claims 1 and 16, it is respectfully submitted the Meyer and DesMarais patents fail to teach or suggest the absorbent article of claims 4, 5, and 9 and the methods of claims 19 and 20, and, therefore, that these claims are also patentable.

**CLOSING REMARKS**

It is respectfully submitted that the subject application, including claims 1, 4, 5, 9, 16, 19, and 20, is in condition for allowance. Confirmation of the allowance is respectfully requested.

The Examiner is invited to contact the undersigned if there are any issues which remain, preventing the allowance of the application.

Respectfully submitted,



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Dated: December 16, 2003

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